

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

The present invention concerns a method for operating a computer-based system. The method generally comprises the steps of (a) receiving into the system an approval for authorizing a particular billing code of a first plurality of billing codes each having a first budget amount stored in a first database, (b) determining whether the particular billing code is present in a second database comprising a second plurality of billing codes each having a second budget amount, (c) generating a communication from the system authorizing the second budget amount associated with the particular billing code in response to the particular billing code matching one of the second plurality of billing codes, and (d) generating the communication authorizing the first budget amount associated with the particular billing code in response to the particular billing code matching none of the second plurality of billing codes.

SUPPORT FOR THE CLAIM AMENDMENTS

Support for the claim amendments can be found in the specification, for example, on page 32 line 26-page 33 line 2, page

43 and lines 22-23 as originally filed. Thus, no new matter has been added.

CLAIM REJECTIONS UNDER 35 U.S.C. §101

The rejection of claims 1-4, 21-28 and 31 under 35 U.S.C. §101 is respectfully traversed and should be withdrawn.

Independent claims 1 and 21 have been amended to clarify the subject matter in the interest of advancing the prosecution. Claims 1-4 and 21-28 and 31 are to a method for operating a computer-base system that generates a useful, concrete and tangible results (e.g., a communication and an approval) per MPEP §2106 IV B 2 (b) ii). As such, the claimed invention is to statutory subject matter under 35 U.S.C. §101 and the rejection should be withdrawn.

Furthermore, the Office Action has failed to establish a *prima facie* case of non-compliance with 35 U.S.C. §101 for (i) lack of evidence that the claimed invention as a whole is directed to solely an abstract idea of to manipulation of abstract ideas of does not produce a useful result and (ii) lack of a statement how the language of the claims have been interpreted to support the rejection. (MPEP §2106 II A) Page 2, section 2 of the Office Action provides a conclusory statement that "no practical application in the technological art is found." In contrast, the

Field of the Invention paragraph on page 1 of the application states that the invention is "particularly useful in connection with the management of projects comprising multiple, serial events." Page 12, lines 9-11 of the application state a practical application for managing intellectual property prosecution for a company. Thus, the claimed invention has practical applications.

Furthermore, no interpretation of the claim language was provided in the Office Action in support of the rejection. Page 2, section 2 of the Office Action only appears to provide a list on conclusory statements about what the claims are not. As such, the Office Action has failed to establish a *prima facie* case of non-compliance with 35 U.S.C. §101 and the rejection should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §112

The rejection of claim 3 under 35 U.S.C. §112, second paragraph, is respectfully traversed and should be withdrawn.

Claim 3 provides generating an authorization form for a task before determining whether a particular billing code is present in a second database. The suggestion on page 3, section 3 of the Office Action that the sequence of generating and determining is backwards is incorrect. Page 39, step 11 of the application provides the computer system preparing an authorization

form. Page 39, step 13 of the application provides an in-house patent attorney selecting a law firm. Finally, page 39, step 14 of the application provides the computer system checking a task budget database for the particular law firm. Therefore, generation of the authorization form before determining whether a particular billing code is present in a second database is correct, clear and definite. As such, claim 3 is fully compliant with 35 U.S.C. §112, second paragraph and the rejection should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1-4 and 8-11 under 35 U.S.C. §103(a) as being unpatentable over Heckman et al. '431 (hereafter Heckman) is respectfully traversed and should be withdrawn.

The rejection of claims 15-16, 18, 20-22, 34-35 and 30-31 under 35 U.S.C. §103(a) as being unpatentable over Heckman in view of Giannini '241 is respectfully traversed and should be withdrawn.

The rejection of claims 26-29 under 35 U.S.C. §103(a) as being unpatentable over Heckman in view of Giannini and in further view of Ensel et al. '685 (hereafter Ensel) is respectfully traversed and should be withdrawn.

Heckman teaches a legal strategic analysis planning and evaluation control system and method (Title). Giannini teaches a method and system encoding and processing alternative healthcare

provider billing (Title). Ensel teaches an electronic account presentation and response system and method (Title). Heckman, Giannini and Ensel alone, or in combination, do not appear to teach or suggest every element of the claimed invention. Furthermore, the Office Action has failed to establish a *prima facie* case of obviousness to combine the references. As such, the claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Claim 1 provides (a) receiving into a system an approval for authorizing a particular billing code of a first plurality of billing codes each having a first budget amount stored in a first database, (b) determining whether the particular billing code is present in a second database comprising a second plurality of billing codes each having a second budget amount, (c) generating a communication from the system authorizing the second budget amount associated with the particular billing code in response to the particular billing code matching one of the second plurality of billing codes, and (d) generating the communication authorizing the first budget amount associated with the particular billing code in response to the particular billing code matching none of the second plurality of billing codes. Despite the assertion on page 4, lines 1-6 of the Office Action, Heckman appears to be silent for receiving an approval for authorizing a particular billing code.

None of the text cited in the Office Action mention the system of Heckman receiving an approval or its equivalent. Heckman also appears to be silent regarding determining whether the particular billing code is present in a second database. Heckman further appears to be silent for generating a communication authorizing a budget amount. Therefore, Heckman does not appear to teach or suggest steps (a) through (d) as presently claimed.

Furthermore, the Office Action has not established a *prima facie* case that it would have been obvious to modify the system of Heckman to add a second database, determine whether the particular billing code is present in the second database, or generate a communication having a first budget amount or a second budget amount. An assertion that modifying the prior art to meet the claimed invention would have been obvious to one of ordinary skill in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason. Furthermore, the Office Action fails to provide particular findings as to the reasons a skilled artisan, with no knowledge of the presently claimed invention, would have modified the cited reference as suggested in the Office Action. The factual inquiry whether to modify the reference must be thorough and searching. The rigorous application of the requirement for showing the teaching or motivation to modify the reference is necessary to avoid the subtle

but powerful attraction of a hindsight-based obviousness analysis. It is improper, in determining whether a person of ordinary skill in the art would have made the proposed modifications, simply to use that which the inventor taught against its teacher. The fact that the Office Action proposes modifying Heckman to add three of the four claimed steps suggests that the claim itself was used as a template for determining the modifications. Furthermore, the Office Action does not provide any evidence of utility even if the proposed second database was added to the system of Heckman. Because the Office Action fails to provide particular findings as to the reasons a skilled artisan, with no knowledge of the presently claimed invention, would have chosen the proposed modification the Office Action does not appear to have met the Office's burden of factually establishing a *prima facie* case of obviousness (MPEP §2142 and §2143.01). As such, the claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Claim 8 provides language similar as claim 1 in "means for" format. Therefore, Heckman does not appear to teach or suggest the elements of claim 8. In addition, the Office Action has not established a *prima facie* case to modify Heckman in such as way as to make claim 8 obvious to one of ordinary skill in the art.

As such, the claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Claims 3 and 10 provide generating an authorization form for a task. Page 5, lines 1-2 of the Office Action state that claim 3 is rejected for the same rational as claim 1. Page 5, lines 13-14 of the Office Action state that claim 10 is rejected for the same rational as claim 1. In contrast, none of the rational for rejecting claim 1 on page 4 of the Office Action addresses generating an authorization form for a task. Furthermore, Heckman appears to be silent regarding a generation of an authorization form. The Examiner is therefore respectfully requested to either (i) provide a clear and particular explanation why claims 3 and 10 are rejected or (ii) withdraw the rejection.

Claims 4 and 11 provide receiving a selection of a firm associated with the second budget database. Despite the assertion on page 5, lines 5-7 of the Office Action, column 4, line 60 through column 5, line 33 of Heckman does not appear to teach or suggest receiving a selection of a firm. Column 4, line 60 through column 5, line 33 of Heckman is a list of objects of the invention for Heckman, none of which appear to teach or suggest receiving a selection of a firm. In addition, the claim language is for **receiving a selection** and not a **means for selecting** as suggested on page 5, line 6 in the Office Action.

Furthermore, the Office Action merely provides a conclusory statement that it would have been obvious to modify the system of Heckman to add receiving a selection. Again, conclusory statements are not evidence of motivation to make the suggested change. The Office Action does not provide any evidence why one of ordinary skill in the art would be motivated to make the proposed modifications other than the teachings of the Applicant. Therefore, the Office Action has failed to establish a *prima facie* case of obviousness. As such, claims 4 and 11 are fully patentable over the cited reference and the rejection should be withdrawn.

Regarding claims 15-16, 18, 20-22, 24-25 and 30-31, the statement on page 6, lines 3-5 of the Office Action that "Heckman et al. have all the features of the invention but lack a means for receiving a bill having a billing code, a billing amount and an approved payment of the billing amount." is an improper omnibus rejection that should be withdrawn (MPEP §707.07(d)). Furthermore, 37 CFR §1.104(b) states:

(b) *Completeness of examiner's action.* The examiner's **action will be complete as to all matters**, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters of form need not be raised by the examiner until a claim is found allowable. (Emphasis added)

In the interest of keeping the prosecution moving, Applicant will respond to the omnibus rejection as best as possible.

Claim 21 provides generating an approval from a system for payment of a billing amount in response to the billing amount not exceeding an authorized amount. In contrast, Heckman appears to be silent regarding generating an approval for payment of a billing amount if the billing amount does not exceed an authorized amount. Column 18, lines 55-56 of Heckman teach monitoring actual costs and identifying deviations from budgeted costs. However, Heckman appears to be silent for what to do when there is no deviation or the deviation is negative. Therefore, Heckman alone does not appear to teach or suggest generating an approval from a system for payment of a billing amount in response to the billing amount not exceeding an authorized amount as presently claimed.

The cite on page 6, lines 11-14 of the Office Action to column 8, lines 24-27 of Giannini does not appear to cure the above missing step. Column 8, lines 24-27 of Giannini read:

The zip code portion of the membership code stored in the PD database 20 is the basis for subsequent comparison of scope of practice codes defining the limits of allowable fees and regulated procedures as legislated from state to state.

Nowhere in the above quote does a step of generating an approval for payment of a billing amount appear to be taught or suggested. Therefore, Heckman and Giannini alone, or in combination, do not appear to teach or suggest generating an approval from a system for payment of a billing amount in response to the billing amount not exceeding an authorized amount as presently claimed.

Furthermore, the Office Action provides no motivation to combine Heckman with Giannini. In particular, page 6, lines 8-11 of the Office Action merely conclude that the combination would be obvious. As argued above for claim 1, establishing a *prima facie* case for obviousness requires clear evidence of motivation to make the combination. Therefore, the Office Action has not established a *prima facie* case of obviousness to combine Heckman and Giannini. As such, the claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Claim 15 provides language similar as claim 21 in "means for" format. Therefore, Heckman and Giannini alone, or in combination, do not appear to teach or suggest the elements of claim 15. In addition, the Office Action has not established a *prima facie* case to modify Heckman and Giannini in such as way as to make claim 15 obvious to one of ordinary skill in the art. As such, the claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Claims 17 and 23 provide checking whether a task has been completed before approving payment of a bill. In contrast, page 6, lines 15-17 of the Office Action concede that both Giannini and Heckman do not explicitly mention checking whether a task has been completed before approving a bill. Since neither Heckman or Giannini alone teach or suggest the claimed task, the assertion

that a combination of two reference would somehow obviously teach the step is conclusory. No evidence or explanation is provided in the Office Action why the step would be obvious in the combination when the Office Action admits that neither reference even mentions the step of checking whether a task has been completed before approving payment of a bill. Therefore, Heckman and Giannini alone, or in combination, do not appear to teach or suggest checking whether a task has been completed before approving payment of a bill as presently claimed. As such, the claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Claims 18 and 24 provide not approving payment in response to an authorization being less than a billing amount. The Office Action provides no evidence that Heckman and Giannini alone, or in combination, teach or suggest not approving payment in response to an authorization being less than a billing amount. Furthermore, the Office Action only provides a conclusory statement that not approving payment would be obvious. As such, the Office Action has failed to establish a *prima facie* case of obviousness and the rejection should be withdrawn.

Claims 20 and 25 provide that the bill comprises an electronic spreadsheet. Despite the assertion on page 6, lines 5-6 that Giannini teaches a bill being an electronic spreadsheet, a

through search of Giannini did not find any references to spreadsheets, electronic or otherwise. Therefore Heckman and Giannini alone, or in combination do not appear to teach or suggest a bill comprising an electronic spreadsheet as presently claimed. As such, claims 20 and 25 are fully patentable over the cited references and the rejection should be withdrawn.

Regarding claims 26-29, the Office Action merely provides a conclusory statement that it would be obvious to combine Heckman and Giannini with Ensel. In particular, no evidence is provided why one of ordinary skill in the art would be motivated to make the suggested combination. Simply because references can be combined is not sufficient to establish *prima facie* obviousness. (MPEP §2143.01). As such, the Office Action as failed to establish a *prima facie* case of obviousness and thus the rejection should be withdrawn.

Furthermore, claim 28 provide entering one of a first budget amount and a second budget amount into a third database. The Office Action provides no evidence that Heckman, Giannini and/or Ensel teach or suggest entering one of two budget amounts into a third database as presently claimed. Therefore, the Examiner is respectfully requested to either (i) provide a ground for rejecting claim 28 or (ii) withdraw the rejection.

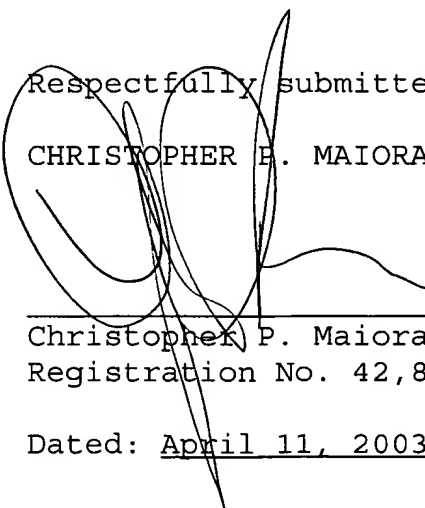
The Office Action has not developed the grounds of rejection for claims 3, 10, 15-16, 18, 20-22, 24-25, 28 and 30-31 to such an extent that the Applicant may readily judge the advisability of an appeal or continued prosecution. Therefore, it is respectfully requested that subsequent rejections, if any, be provided in a **non-final office action** (MPEP §706.07).

Accordingly, the present application is believed to be in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicants' representative at 586-498-0670 should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 12-2252.

Respectfully submitted,
CHRISTOPHER E. MAIORANA, P.C.



Christopher P. Maiorana
Registration No. 42,829

Dated: April 11, 2003

c/o Sandeep Jaggi
Intellectual Property Law Department
LSI Logic Corporation
1551 McCarthy Boulevard, M/S D-106
Milpitas, CA 95035

Docket No.: 99-392 / 1496.00269

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (CURRENTLY AMENDED) A method for operating a computer-based accounts payable system, said method comprising the steps of:

a. receiving into said system an approval for
5 authorizing a particular billing code of a first plurality of billing codes each having a first budget amount stored in a first database;

b. determining whether said particular billing code is present in a second database comprising a second plurality of
10 billing codes each having a second budget amount;

c. generating a communication from said system authorizing said second budget amount associated with said particular billing code in response to said particular billing code matching one of said second plurality of billing codes; and

15 d. generating said communication authorizing said first budget amount associated with said particular billing code in response to said particular billing code matching none of said second plurality of billing codes.

21. (CURRENTLY AMENDED) A method for operating a computer-based system for handling accounts payable, said method comprising the steps of:

a. receiving into said system a bill comprising a
5 billing code and a billing amount associated with said billing code;

b. determining an authorized amount associated with said billing code from a database; and

c. generating an approval from said system for
10 [approving] payment of said billing amount in response to said billing amount not exceeding said authorized amount.